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AF/2635
#15 Reply Brief
6/15/04
(ta)

PATENT APPLICATION
09/640,552

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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JUN 08 2004

Technology Center 2600

In re Application of:

Johannes Igl ✓

Serial No.:

09/640,552 ✓

Date Filed:

August 17, 2000 ✓

Group Art Unit:

2635 ✓

Examiner:

Clara Yang ✓

Title:

A DEVICE FOR IDENTIFYING
AUTHORIZATION AND
TRIGGERING/ENABLING AND ACTION,
PREFERABLY AN ELECTRONIC LOCKING
DEVICE FOR MOTOR VEHICLES

MAIL STOP – APPEAL BRIEF-PATENTS

Commissioner for Patents

P.O. Box 1450

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I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail No. EV352395355US addressed to: Mail Stop – Appeal Brief-Patents, Commissioner of Patents, Office, P.O. Box 1450, Alexandria, VA 22313-1450, on June 2, 2004.

Shannon Judice

Shannon Judice

Dear Sir:

REPLY BRIEF PURSUANT TO 37 CFR §1.193(b)

Applicant has appealed to the Board of Patent Appeals and Interferences from the decision of the Examiner mailed August 12, 2003, finally rejecting Claims 1-11 and 14-17. Applicant filed a Notice of Appeal on November 10, 2003 and an Appeal Brief on January 12, 2004. The Examiner mailed an Examiner's Answer on April 2, 2004. Applicant respectfully submits herewith this Reply Brief, in triplicate.

SYNCHRONOUS TIME INFORMATION

Applicant's invention relates to a device for identifying authentic information and enabling an action. The device comprises a base unit and a key unit that both include "accurately-timed digital generators running essentially synchronously with respect to one another and generating digital output information that changes at predetermined time intervals." The key unit "combin[es] the digital information of the key unit digital generator with a stored identification code in accordance with a predetermined coding rule to form a coded information item," and the base unit "us[es] the predetermined coding rule to code the predetermined information with the digital information of the base unit digital generator to form a predetermined coded information item." The base unit further enables an action when the coded information item generated by the key unit matches the predetermined coded information item generated by the base unit.

The Examiner rejected Claim 1 as being unpatentable over U.S. Patent No. 6,265,963 issued to Clifton W. Wood, Jr. ("Wood") in view of U.S. Patent No. 5,412,379 issued to Thomas J. Waraksa et al. ("Waraksa") and in further view of U.S. Patent No. 6,130,623 issued to John Austin MacLellan et al. ("MacLellan"). The Examiner puts forth several unpersuasive arguments to support her position. First, the Examiner mischaracterizes Claim 1 by stating that "Claim 1 simply calls for a key unit that transmits information to a base unit, wherein the key unit's and base unit's information periodically changes based on a predetermined coding rule. Encoding data with time information and exchanging time information are not required." (Examiner's Answer, Page 13). Applicant's Claim 1 recites a device comprising

b) [a] base unit and [a] key unit [that] include respective accurately-timed digital generators running essentially synchronously with respect to one another and generating digital output information that changes at predetermined time intervals;

c) the key unit combining the digital information of the key unit digital generator with a stored identification code in accordance with a predetermined coding rule to form a coded information item;

d) the base unit using the predetermined coding rule to code the predetermined information with the digital information of the base unit digital

generator to form a predetermined coded information item, and comparing the predetermined coded information item with the coded information item communicated by the key unit, the base unit enabling the action when the coded information item communicated matches the predetermined coded information item.

Both the base unit and the key unit generate coded information using their respective “accurately-timed digital generators” and the base unit compares the coded information received from the key unit with the coded information from the base unit. Thus, Applicant’s claimed invention clearly includes coding by means of synchronous time information and the exchange of synchronous time information.

Second, the Examiner asserts that it would have been obvious to modify the system of Wood as taught by Waraksa and MacLellan. (Examiner’s Answer, Page 5). Even if the combination of Wood, Waraksa and MacLellan is proper, there is no showing of “the key unit combining the digital information of the key unit digital generator with a stored identification code in accordance with a predetermined coding rule to form a coded information item,” and “the base unit using the predetermined coding rule to code the predetermined information with the digital information of the base unit digital generator to form a predetermined coded information item,” as recited by Applicant’s Claim 1. Waraksa teaches that a beacon generates a valid coded signal in response to a changing CLOCK code (Col. 10, Lines 33-41) and that a receiver determines a function to be performed by decoding the valid signal from the beacon. (Col. 15, Lines 53-57). MacLellan suggests the use of digital encryption techniques to exchange information between a Tag and an Interrogator. (Col. 4, Lines 38-65). As described in the Appeal Brief, neither Wood, Waraksa nor MacLellan disclose, suggest or teach coding information generated by the key unit and the base unit by means of synchronous time information. As such, Applicant respectfully traverses the Examiner’s analysis and the rejections based upon it.

NO MOTIVATION TO COMBINE

The Examiner asserts that the combination of Wood and Waraksa is proper because “those of ordinary skill in the art would recognize that it would be difficult for a would-be thief to determine device 12’s authorization code if Wood’s device 12 changes its code at

predetermined intervals as taught by Waraksa.” (Examiner’s Answer, Page 13). Applicant respectfully submits that there is no suggestion to modify the system of Wood, which is directed to object monitoring using an interrogator and a transponder, with the passive keyless entry system of Waraksa that allows battery power of a vehicle to be conserved.

According to the Manual of Patent Examining procedure:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Manual of Patent Examining Procedure, § 2143 (emphasis added). “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992).

Waraksa teaches away from, rather than suggests, combining its passive keyless entry system with the interrogator/transponder system of Wood. Wood discloses that an interrogator transmits a command and switches to a continuous wave mode, where the interrogator hops between various frequencies, to wait for a response to the command. (Col. 8, Lines 45-67). In contrast, Waraksa teaches that interrogation/transponder-type systems are not suitable for automotive use because the interrogator must be on and interrogating at all times, which causes a power consumption problem. (Col. 1, Lines 39-57). Waraksa, therefore, teaches away from using a rolling code in the interrogator/transponder system of Wood since the interrogator would be operating in a continuous wave mode when waiting to receive the rolling code.

Additionally, it is improper to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is

rendered obvious. *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). Only by using impermissible hindsight reconstruction of the disclosures of Wood and Waraksa based on Applicant's disclosed invention can the Examiner determine that the system of Wood be modified to allow changing codes at predetermined intervals as described in Waraksa.

Absent a suggestion to modify the disclosed system in Wood with the disclosed system in Waraksa, the Examiner's obviousness rejection is improper. As such, Applicant respectfully traverses the Examiner's § 103 rejections.

CONCLUSION

Applicant has demonstrated that the present invention as claimed is clearly distinguishable over the art of record. Therefore, Applicant respectfully requests the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

Although no fee is believed to be due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0383 of Baker Botts, L.L.P.

Respectfully submitted,

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Date: June 2, 2004

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